

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANFRED NEUBERGER

Appeal No. 1999-2485
Application 08/737,118

ON BRIEF

Before WARREN, TIMM and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief and reply brief, and based on our review, find that we cannot sustain the rejection of appealed claims 9, 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Nakatsuka et al. (Nakatsuka) in view of Yoshikawa, Hurst et al. (Hurst) and Nakayama et al. (Nakayama), and of appealed claims 10 through 12¹ under 35 U.S.C. § 103(a) as being unpatentable over Nakatsuka in view of Yoshikawa, Hurst and Nakayama as applied to claim 15 further in view of Blanco.² For the reasons pointed out by appellant in the brief and reply brief, the examiner has failed to make out

¹ Appealed claims 9 through 142, 15 and 16 are all of the claims in the application.

² Answer, pages 3-7.

a *prima facie* case with respect to both of the grounds of rejection.

In order to establish a *prima facie* case of obviousness, the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). The requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.

Appellant acknowledges in the specification that rotogravure processes of producing transfer printing papers by applying printable ceramic coloring pigments in a release composition to the paper via transfer from a rotogravure cylinder are known, citing "DE-A-42 03 162"³ (e.g., pages 1-5). However, instead of applying this reference to the claims, the examiner has assembled Nakatsuka, Yoshikawa, Hurst and Nakayama, contending that the combined teachings of these references would have suggested a process of preparing transfer printing papers with a rotogravure process, and that this combination along with other knowledge and observations that could have been made by one of ordinary skill in this art, would have satisfied the limitations of appealed claim 15 (answer, pages 4-6).

On this record, we must agree with appellant that the combination of references and knowledge in the art taken as a whole as relied on by the examiner, would not have suggested the claimed invention as a whole, including each and every limitation of the claims, to one of ordinary skill in this art in the absence of appellant's specification. While each of the references

does show the particular printing process for which that reference is cited by the examiner, there is nothing in the general nature of the disclosure of the printing process in the context of the invention disclosed in each reference which would have suggested to one of ordinary skill in this art that other printing processes than those disclosed in Nakasuka can be used for preparing the transfer paper taught in this reference. Thus, at best, the examiner has shown only that rotogravure printing processes are known. *See, e.g.*, Hurst, col. 2, lines 10-11: “Such printing [of a pattern on lacquer] may be carried out by the screen process, roto-gravure or other orthodox techniques.”

Indeed, with respect to the process of appealed claim 15, the applied prior art does not suggest employing multiple printable ink compositions in “cups” on the rotogravure cylinder which have a depth of 20 μm to 60 μm . The only description of a gravure apparatus in the prior art applied by the examiner is provided by Nakayama in disclosing a “print plate having fine-groove-shaped gravure cells communicated with one another, and independent banks . . . and a plate depth of 20 μm ” (col. 6, lines 46-49; see also col. 4, lines 14-19, and FIGs. 2 and 3). Thus, the “cells” are “groove-shaped” rather than “cups,” and the plate, not the “cups,” has a “depth of 20 μm ,” and is used to provide “fine lines . . . by special gravure printing” as “compared with general gravure printing by which paint is printed in the form of a set of a large number of points” (col. 4 lines 44-52).

Thus, we reverse both grounds of rejection. *Cf. In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967) (“Thus, where the invention sought to be patented resides in a combination of old elements, the proper inquiry is whether *bringing them together was obvious* and not, whether one of ordinary skill having the invention before him, would find it obvious through hindsight to construct the invention from elements of the prior art.”).

³ This reference was supplied by appellant in the information disclosure statement of March 27, 1997 (Paper No. 8) and considered by the examiner on October 30, 1997 as seen from the signed

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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Kurt Kelman
Collard & Roe
1077 Northern Boulevard
Roslyn, NY 11576